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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,754	03/23/2004	Silke Wolff	2124A	2419

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STRIKER, STRIKER & STENBY
103 East Neck Road
Huntington, NY 11743

EXAMINER

BOLDEN, ELIZABETH A

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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04/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/806,754

Applicant(s)

WOLFF ET AL.

Examiner

ELIZABETH A. BOLDEN

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6 and 16-27 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6 and 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 16 and 19 is/are rejected.
- 7) ☒ Claim(s) 17, 18 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/137,930.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, Claims 1-3 and 16-20 in the reply filed on 9 January 2008 is acknowledged.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/137,930, filed on 10 July 2002.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3 are indefinite because no specific composition for the material is set forth. "An article characterized by physical properties alone and no specific composition is vague and indefinite". See *Ex parte Slob*, 157 USPQ 172.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shizuo et al., German Patent 3130715.

In reciting this rejection, the examiner will cite the Derwent Abstract 1982-16006E.

Shizuo et al. disclose an optical glass having overlapping components with instant claim 16. See Derwent Abstract. Shizuo et al. disclose ranges for the refractive index and Abbe number of the optical glass that overlap the refractive index and Abbe number ranges in instant claims 1 and 2. See Abstract. The composition and the refractive index and Abbe number ranges disclosed by the reference are sufficiently specific to anticipate the composition and refractive index and Abbe number limitations in claims 1, 2, and 16. See MPEP 2131.03.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Shizuo et al. would inherently possess the same density, spectral transmission purity degree, and partial dispersion as recited in claims 1, 3, and 16. See MPEP 2112.

Claims 1-3 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Matsumaru et al., Japanese Patent Publication 61-163138.

In reciting this rejection, the examiner will cite the Derwent Abstract 1986-234732.

Matsumaru et al. disclose an optical glass having overlapping components with instant claim 16. See Derwent Abstract. Matsumaru et al. disclose ranges for the refractive index and Abbe number of the optical glass that overlap the refractive index and Abbe number ranges in instant claims 1 and 2. See Derwent Abstract. The composition and the refractive index and Abbe number ranges disclosed by the reference are sufficiently specific to anticipate the composition and refractive index and Abbe number limitations in claims 1, 2, and 16. See MPEP 2131.03.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Matsumaru et al. would inherently possess the same density, spectral transmission purity degree, and partial dispersion as recited in claims 1, 3, and 16. See MPEP 2112.

Claims 1-3 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ishibashi et al., U.S. Patent 4,118,238.

Ishibashi et al. disclose an optical glass having overlapping components with instant claim 16. See abstract and column 2, lines 30-51. Ishibashi et al. disclose ranges for the refractive index and Abbe number of the optical glass that overlap the refractive index and Abbe

number ranges in instant claims 1 and 2. See abstract and column 3, lines 12-14. The composition and the refractive index and Abbe number ranges disclosed by the reference are sufficiently specific to anticipate the compositional and refractive index and Abbe number limitations in claims 1, 2, and 16. See MPEP 2131.03.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Ishibashi et al. would inherently possess the same density, spectral transmission purity degree, and partial dispersion as recited in claims 1, 3, and 16. See MPEP 2112.

Claims 1-3 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Inoue et al., U.S. Patent 4,226,627.

Inoue et al. disclose an optical glass having overlapping components with instant claim 16. See column 1, lines 40-59. Inoue et al. disclose ranges for the refractive index and Abbe number of the optical glass that overlap the refractive index and Abbe number ranges in instant claims 1 and 2. See column 1, lines 35-40. The composition and the refractive index and Abbe number ranges disclosed by the reference are sufficiently specific to anticipate the composition and refractive index and Abbe number limitations in claims 1, 2, and 16. See MPEP 2131.03.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Inoue et al. would inherently possess the same density, spectral transmission purity degree, and partial dispersion as recited in claims 1, 3, and 16. See MPEP 2112.

Claims 1-3, 16, and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ishibashi et al., U.S. Patent 4,166,746.

Ishibashi et al. disclose an optical glass having overlapping components and compositional ranges with instant claims 16 and 19. See abstract and column 2, lines 54-68. Ishibashi et al. disclose ranges for the refractive index and Abbe number of the optical glass that overlap the refractive index and Abbe number ranges in instant claims 1 and 2. See abstract and column 1, lines 29-37. The composition and the refractive index and Abbe number ranges disclosed by the reference are sufficiently specific to anticipate the compositional and refractive index and Abbe number limitations in claims 1, 2, 16, and 19. See MPEP 2131.03.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Ishibashi et al. would inherently possess the same density, spectral transmission purity degree, and partial dispersion as recited in claims 1, 3, and 16. See MPEP 2112.

Allowable Subject Matter

Claims 17, 18, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

In reviewing the prior art for these claims, the further restriction of requiring the optical element to have an optical glass consisting only of the recited components in the recited amounts as limited in the instant claim renders these claims allowable.

Conclusion

The additional references cited on the 892 have been cited as art of interest since they are considered to be cumulative to or less than the art relied upon in the rejections above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH A. BOLDEN whose telephone number is (571)272-1363. The examiner can normally be reached on 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1793

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/
Supervisory Patent Examiner, Art Unit 1793

/Elizabeth A. Bolden/
Elizabeth A. Bolden
Examiner
Art Unit 1793

EAB
28 March 2008